

2007-1057

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

CARITAS TECHNOLOGIES, INC.

Plaintiff-Appellant,

v.

COMCAST CORPORATION, COMCAST CABLE COMMUNICATIONS,
LLC., COMCAST IP PHONE, LLC (doing business as Comcast Digital
Voice), and COMCAST IP PHONE II, LLC, (doing business as Comcast
Digital Voice).

Defendants-Appellees.

APPEALS FROM THE UNITED STATES DISTRICT COURT FOR THE
EASTERN DISTRICT OF TEXAS IN CASE NO. 2:05-CV-339
JUDGE DAVID J. FOLSOM

**REPLY BRIEF OF PLAINTIFF-APPELLANT
CARITAS TECHNOLOGIES, INC.**

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March 22, 2007

CERTIFICATE OF INTEREST

Counsel for the appellant Caritas Technologies, Inc. certifies the following:

1. The full name of every party or amicus represented by me is: Caritas Technologies, Inc.
2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is: None
3. All parent corporations and publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are: None
4. There is no such corporation as listed in paragraph 3.
5. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:

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TABLE OF CONTENTS

CERTIFICATE OF INTEREST	i
TABLE OF CONTENTS.....	iii
TABLE OF AUTHORITIES	vi
I. INTRODUCTION	1
A. The District Court’s Error	1
B. Comcast’s Dilemma	3
II. THE DISTRICT COURT’S ERRONEOUS CONSTRUCTION EXCLUDES ALL EMBODIMENTS OF THE PATENT	4
A. Comcast Cannot Rewrite The District Court’s Construction In Order To “Save” It	5
B. “Telephone Devices” In the District Court’s Order Means the Conferees’ “Telephones,” Which Excludes The Preferred Embodiments From the Claims.....	7
C. The District Court’s Judgment and Rule 54(b) Order Cannot Stand If “Telephone Devices” Is Expanded Beyond Telephone Instruments	11
D. “Telephone Device” Is a Claim Term That Should Not Be Construed In the First Instance On Appeal	13
E. “Telephone Device” Is a Claim Term that Means Telephone Instrument, Not Telephone Switches or Bridges.....	14
III. THE INTRINSIC EVIDENCE SUPPORTS CARITAS’S CONSTRUCTION, AND REFUTES THE DISTRICT COURT’S CONSTRUCTION	17

A.	“Telephonic Connections” Established By the Invention Are Different From Those Established for Ordinary Calls and Conferences.....	18
1.	The Caritas Patent Discloses Establishing Telephonic Connections Between Switch 34 and a Conferee Telephone Using Control Signals Sent From Outside the Telephone Network.....	19
2.	The Prior Art Method for Setting Up An Ordinary Two-Person Conference Differs Significantly From The Patent’s Method, and Establishes a Different Kind of Connection	21
3.	The Prior Art Method of Setting Up A Three-Person Conference Using a Conference Bridge Also Differs Significantly From The Patent’s Method, and Establishes a Connection Excluded From the District Court’s Definition	22
B.	Comcast’s Claim To “Ordinary Meaning” Is False	24
C.	The District Court’s Construction of “Telephonic Connections” Improperly Imports Extraneous Limitations Into Claim 33	26
D.	Comcast Does Not Dispute That Claims 1 and 17 Are Not Limited To a Specific End Point.....	28
E.	Dependent Claims 9 and 10 Support Caritas’s Proposed Construction, and Refute the District Court’s Construction	29
F.	The Prosecution History Supports Caritas’s Proposed Construction	30

1.	The '780 Patent's Use Of the Term "Telephonic Connections" Supports Caritas's Proposed Construction.....	30
2.	The Abstracts' Use Of the Term "Telephonic Connections" Supports Caritas's Proposed Construction.....	31
3.	Caritas's Statements Regarding the White Patent Support Caritas's Proposed Construction and Refute Comcast's Argument That Caritas Disclaimed Coverage Of VoIP.....	32
CONCLUSION.....		34

TABLE OF AUTHORITIES

Cases

<i>Bayer AG v. Biovail Corp.</i> , 279 F.3d 1340 (Fed. Cir. 2002).....	14
<i>Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc.</i> , 381 F.3d 1111 (Fed. Cir. 2004)	27, 30
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005)	14, 27, 28
<i>Rodime PLC v. Seagate Tech., Inc.</i> 174 F.3d 1294 (Fed. Cir. 1999)	31

I. INTRODUCTION

A. The District Court's Error

Simply put, the Caritas '779 patent sends call control signals from outside the PSTN to cause the PSTN to establish telephonic connections for a conference among two or more conferees. Each set of disclosed call control signals sets up one conference member's connection to the conference, with the connection between the conferee's telephone and the conference. The connection may be over a circuit-switched network, such as the PSTN, or a packet-switched network, such as the Internet. This innovative use of sending call control signals from outside the PSTN improves conference communication quality.

Comcast Digital Voice ("CDV") similarly sends call control signals from outside the PSTN to establish telephonic connections for a conference among two or more conferees -- providing its subscribers with a new form of telephone service. On that basis, Caritas brought its infringement suit against Comcast.

The lower court's claim construction, however, defined "telephonic connection" as an end-to-end circuit-switched connection between telephones. Such a definition covers an "ordinary" telephone call over the PSTN, but does not reach a telephone call set-up in accordance with the

claims of the '779 patent. In the patent claims, the “at least one” telephone connection is between a conferee’s telephone and the conference. The definition also does not reach CDV, in which there is a circuit-switched PSTN connection between at least one conferee’s telephone and the conference, but not all the way between two conferees. On that basis, the stipulated judgment of non-infringement was entered below.

The district court’s claim construction, which puts CDV outside its reach, simultaneously excludes every embodiment in the '779 patent and contradicts the intrinsic evidence of the claim language, the specification and the prosecution history. Hence it is erroneous and the judgment must be vacated.

As Caritas demonstrated in the proceedings below, the correct claim construction of “telephonic connection” is “a connection over the ... telephone network associated with a specific conferee.” As demonstrated in Caritas’s main brief, that claim construction is supported by the intrinsic evidence and also brings the embodiments set forth in the patent back within the scope of the patent claims. The correct claim construction similarly covers CDV, requiring a reversal and remand for trial below.

B. Comcast's Dilemma

Comcast's fundamental problem is that after successfully arguing below a "between telephones" construction of "telephonic connection," it has a judgment to defend that has a critical defect: "between telephones" excludes every embodiment in the patent from the claims. Because Comcast desperately wants to cloak itself in the mantle of "ordinary meaning," Comcast continues to hammer home its "between telephones" mantra -- but abandons it at those points when it seeks to deny this critical defect. Then it resorts to rewriting its own position, and that of the district court, now saying a connection is not between "telephones," but between "any 'telephone device,'" including switches, bridges, fax machines and modems -- none of which is mentioned in the district court's opinion.

Comcast does this by redefining another claim term, never construed by the court, "telephone devices" (used in the court's construction of "telephonic connection"). The claim term "telephone devices" should not be construed for the first time on appeal, and certainly should not be construed in a manner unsupported by the district court's ruling or the intrinsic evidence. Moreover, if "telephone devices" means "any" telephone network equipment as Comcast suggests, then the judgment is without factual support, as Comcast admits that its system establishes circuit-switched paths

both between its system and the PSTN, and within the PSTN -- in other words, connections “between telephone devices.”

Comcast’s cloak of “ordinary meaning,” however, is threadbare because it focuses on “ordinary” conferences, not those set up by the invention, which are different from “ordinary” connections precisely because they are established using the inventors’ method of controlling a PSTN switch from outside the telephone network, something “ordinary” methods do not do.

II. THE DISTRICT COURT’S ERRONEOUS CONSTRUCTION EXCLUDES ALL EMBODIMENTS OF THE PATENT

The district court summed up the dispute between the parties in its Order:

- “whether a telephonic connection is associated with a specific conferee (conferee-to-conference) [Caritas’s proposed construction]”
- “or is between two telephones (conferee-to-conferee) [Comcast’s proposed construction].”

A0024 (quoted in Comcast’s Brief at 16).

The district court chose Comcast’s side of the dispute, indicating that a “connection can only connect two conferees,” A0016, and that “a ‘telephonic connection’ must be ‘established’ between ‘conferees’ ...”

A0026-27. Thus, the court concluded that a telephonic connection is

“between telephone devices.” Based on this requirement that a “telephonic connection” be an end-to-end circuit-switched path between conferees, the court found that in CDV, voice signals travel in part “via an internet protocol and are not transmitted over a circuit-switched path,” and “thus, in the [CDV] System, there is no circuit-switched path between telephone devices on a circuit-switched network.” A0002-03 (Order).

The district court’s construction cannot be correct because it excludes from the claims every embodiment in the patent, in which each connection is disclosed as being between switch 34 and a conferee telephone, not between conferee telephone devices.

Caritas’s proposed construction, “a connection associated with a specific conferee,” does not suffer from this problem, as it embraces the disclosures of the preferred embodiments, in which every connection is from switch 34 to a “telephone.” A0083, col. 2, line 45 (“conferees[’] telephones”). Most importantly, Caritas’s construction is consistent with the disclosure’s teaching that each connection is a “conferee[’]s connection,” and is thus associated with a specific conferee.

A. Comcast Cannot Rewrite The District Court’s Construction In Order To “Save” It

Attempting to save the district court’s construction from excluding every embodiment disclosed in the patent, Comcast now rewrites the

construction by proffering an unsupported definition of a second claim term, “telephone devices.” The definition that Comcast now offers is contrary to the meaning given the term by the court, and inconsistent with Comcast’s “between telephones” position. In support of its “conferee-to-conferee” position, Comcast argues before this Court that the ordinary meaning of “telephonic connection” requires that it be “between telephones.” Comcast Brief at 29 (emphasis added). Comcast specifically criticizes Caritas’s “switch-to-telephone” position, *id.* at 30, and goes so far as to assert that the “plain meaning of ‘connection’ is a link between two end points,” *id.* at 31. However, taking the conferee-to-conferee “two end points” position puts Comcast in the bind described above -- the position is inconsistent with the switch-to-conferee disclosures of the patent, and excludes from the claims all the preferred embodiments.

Comcast attempts to solve its dilemma by now redefining the claim term “telephone devices” to mean any telephone network equipment, including telephone network equipment such as switches and bridges, in an effort to encompass the switch-to-telephone connections of the preferred embodiments. This sleight-of-hand is inconsistent with the court’s order,

with the disclosures of the patent, and with Comcast's own arguments both below and in its own brief before this Court.¹

B. “Telephone Devices” In the District Court’s Order Means the Conferees’ “Telephones,” Which Excludes The Preferred Embodiments From the Claims

In its claim construction order, the district court made clear that by “telephonic devices” it meant conferee telephones, and that it was specifically rejecting the idea that a telephone switch, such as switch 34 in the specification, could be a “telephone device.”

The district court noted when it addressed the issue of “plurality of conferees,” that “the specification discusses controlling the ‘conferees[’] telephones,’” and thus “refers to a telephone as something that a conferee possesses ...” A0015. In the same discussion, the court further noted that “one connection can only connect two conferees.” A0016. These statements show that the telephone devices must be where the conferees are -- in other words, telephones, not switches or bridges, such as switch 34.

¹ Caritas's expert never said switch 34 is or must be a conference bridge. Dr. Forys stated, in response to the question “Could the bridge be a switch?”, that a “bridge is a function -- is part of a switch, [a] special component of a switch.” A1534 (Deposition of Caritas's Expert at 163). He also noted that, in the patent disclosure, “[i]t appears to be that I’m going to a switch. I’m controlling a switch to make a connection first to one then to another. The implication [is] there is the bridge there or something that connects them together.” *Id.* at 165 (emphasis added).

In discussing the construction of the term “telephonic connection,” the court quoted Comcast’s proposed construction of telephonic connection: a “switched circuit path between two telephones.” A0024 (emphasis added).

The court then defined the issue to be decided:

The parties disagree about ... whether a telephonic connection is associated with a specific conferee (conferee-to-conference) [as proposed by Caritas] or is between two telephones (conferee-to-conferee). Dkt. No. 135 at 17 [A0514 (Caritas *Markman* Brief)].

...
The parties disagree as to whether a “telephonic connection” is a connection associated with a specific conferee or is any path between two telephone devices. Dkt. Nos. 135 at 17 & 160 at 16 [A1379, Comcast *Markman* Brief]... Defendant argues that a “telephonic connection” is an end-to-end connection between telephones.

A0024 (emphasis added).

The district court here used the phrases “between telephones (conferee-to-conferee)” and “between telephone devices” interchangeably -- and not to refer to switches, such as switch 34, which are not conferee telephone instruments.² Indeed, the lower court here cites a page of Comcast’s brief which five times refers to “between telephones” and never mentions any other telephone network equipment. A1379 (Comcast *Markman* Brief). Thus, the court went on to say: “The parties’ only other

² The term “telephone devices” appears nowhere in the parties’ briefs below, except when quoting Claim 33, which explicitly requires “conferee telephone devices.”

disagreement with respect to this claim phrase is whether a telephonic connection is an end-to-end path between telephones, or a connection that is associated with a specific conferee.” *Id.* (emphasis added). *See also* A0025 (court noting that Comcast argues “end-to-end connection”). The court also observed that Comcast “argues that construing ‘telephonic connection’ to mean a connection from a conferee to a switch must fail.” A0024 (emphasis added).

In setting forth its claim construction the district court repeated verbatim its earlier formulation of the dispute, complete with citations to the parties’ briefs: “whether a ‘telephonic connection’ is ‘a connection associated with a specific conferee’ or is a ‘path between two telephone devices.’” A0026 (citations omitted, emphasis added). It then noted how, in its view, connections were between conferee “telephones.” The court stated that the specification discloses establishment of a connection “between ‘conferees,’” and that it is “conferees[’] telephones” that are controlled by the invention.³ A0026-27. The court further determined that a connection must be “between telephone devices” by focusing on the use of the terms

³ Caritas disagrees with this characterization of the specification, which specifically discloses a connection from switch 34 (which is not a conferee) to a conferee. However, this passage shows what was meant by the district court when it rejected Caritas’s proposed construction, and used the term “telephone devices.”

“conferee telephone device” and “conferee[']s telephones” in the specification. A0027. Said the court: “Thus, the term ‘telephonic connection’ refers to connections between telephone devices.” *Id.* These passages show that the court was focusing on conferee telephones, not switch 34 or other telephone switches which are not conferee telephone call end points.

The district court also relied on *Newton*’s dictionary definition offered by Comcast, which defines a connection as a “path between telephones.” A0028 (emphasis added). Making clear that the court was adopting an end-to-end construction -- from one conferee to another -- is the court’s statement in the same paragraph that “[b]etween any two conferrees there is, at least in part, a circuit path. Otherwise, those conferees would be unable to confer.” A0028 (emphasis added).

Finally, when construing “connection status information,” the district court again noted Comcast’s insistence that the “connection” be “between two telephones.” A0029. The court adopted Comcast’s interpretation to the extent it indicated such information concerns a “path between two telephones.” A0033. *See* A1378 (Comcast *Markman* Brief) (“switched circuit path between two telephones”). This confirms that the court used

“telephone devices” to mean “telephones” -- and to not encompass telephone switches such as switch 34.

Thus, the district court’s opinion leaves no doubt that “telephonic devices” means conferee telephones, and excludes switch 34. The court uses the term “telephones” and “telephone devices” interchangeably, and never mentions switches except when noting what Caritas proposed: that a connection is between the conferee and the conference.

Because the district court’s construction requires end-to-end connections between conferees (*i.e.*, between two telephones), it excludes the embodiments of the patent, which all disclose only switch-to-phone telephonic connections.

C. The District Court’s Judgment and Rule 54(b) Order Cannot Stand If “Telephone Devices” Is Expanded Beyond Telephone Instruments

The court’s Order on the entry of Rule 54(b) judgment confirms that the court meant “telephone devices” to mean conferee telephone instruments -- not switches, conference bridges or other telephone network equipment. The court determined that although there is a circuit-switched path within the public switched telephone network (PSTN), and from Comcast’s Media Gateway (MG) to the PSTN, the path from Comcast’s MG to the Comcast subscriber is not circuit-switched. A0002-03. The court concluded:

“[T]hus, in the [CDV] System, there is no circuit-switched path between telephone devices on a circuit-switched network,” *id.*, and thus no infringement.⁴

The court’s conclusion makes sense if “telephone devices” means telephone instruments: there is no telephone-to-telephone circuit-switched path in a call set up using CDV. Rather, the path between telephones is part internet protocol, and part circuit-switched, with the MG being the meeting point for these two parts. Under this view, there is no conferee-to-conferee circuit-switched path.

However, the lower court’s conclusion of non-infringement is incorrect if a “telephone device” can be a bridge or switch or other telephone network equipment. If, as the parties agreed, the connections established by CDV “within the [PSTN],” and “between the MG and a switch on the” PSTN, are each a “circuit-switched path,” A1889, then the court could not have concluded that there is no such circuit-switched path. The judgment stands or falls on this finding, for if CDV can establish such circuit-switched paths, judgment of non-infringement is improper based on the record before

⁴ Caritas’s infringement claim is based in part on Comcast’s compliance with PacketCable 1.0, which Comcast admits post-dates the claimed invention by more than three years. Comcast Brief at 15.

the court. Thus, adopting Comcast's position on "telephone device" on appeal would require the judgment to be vacated.

D. "Telephone Device" Is a Claim Term That Should Not Be Construed In the First Instance On Appeal

The term "telephone device" is a claim term, but not one the parties asked the district court to construe. Neither party sought to include "telephone device" as part of the construction of "telephonic connection." Nonetheless, the court used the term in construing "telephonic connection." It is apparent that the court took the term from Claim 33, the only place where the term appears in the record below.

Despite the clear meaning of the lower court's use of "telephone devices," Comcast argues here, for the first time, that "telephone device" has an all-encompassing meaning that is contrary to the way the term is used by the district court, as well as contrary to arguments made to the court by the parties. In doing so, Comcast belatedly seeks appellate claim construction of a term never before construed in the case.

If the Court rejects Comcast's invitation to rewrite the district court's claim construction -- or vacates the judgment on other grounds, such as in connection with adopting Caritas's proposed claim construction, or because the district court's construction, as redefined by Comcast, destroys the factual support for a finding of non-infringement -- the Court need not

address the meaning of “telephone device” as a claim term in the patent.

Otherwise, however, the Court must construe “telephone device” as a claim term according to the procedure set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005).

This Court should not take up Comcast’s implicit invitation to construe this claim term for the first time on appeal, where the district court did not construe the term in the proceedings below, and the parties did not introduce evidence or argument regarding the meaning of “telephone device.” *Bayer AG v. Biovail Corp.*, 279 F.3d 1340, 1349 (Fed. Cir. 2002) (premature to engage in claim construction on appeal without appropriate record). “In sum, this court does not yet have a claim construction to review.” *Id.*

Thus, in this circumstance, the district court’s judgment must be vacated and remanded for further claim construction rulings concerning the claim term “telephone device.” *Id.* (“court cannot affirm ... without a proper claim construction of the relevant claim limitations”).

E. “Telephone Device” Is a Claim Term that Means Telephone Instrument, Not Telephone Switches or Bridges

To the extent it is appropriate to construe “telephone device” for the first time on appeal, this Court should construe “telephone device” to mean

“telephone instrument,” and not as including bridges, or switches like switch 34.

Claim 33 contains the term “conferee telephone device.” A0086, col. 8, line 32. Several dependent claims also contain the same term. *See, e.g.* A0085, col. 6, lines 12-17, A0088 (Claim 2) and A0086, col. 8, lines 38-43, A0090 (Claim 34). These claims reflect the specification’s disclosure that “telephones” and “telephone instruments” belong to the conferees, and are separate from switch 34.

The Abstract recites that “each [conferee] has an independent telephone instrument,” and that a “telephone switch” is used to ring and bring on line “the conferee telephones,” and to provide “telephone status information.” A0077. The term “telephone instrument” is used interchangeably with “telephone” in both the Abstract and in discussing the VoIP embodiment, which references both “telephone 17,” A0084, col. 4, lines 10 and 27, and “telephone instrument 17,” *id.*, col. 4, line 39.

The specification repeats this distinction between conferee telephones, on the one hand, and switches, on the other hand. Thus, “conferee stations” comprise a “telephone,” A0083, col. 2, lines 8-20. The switch, on the other hand, is sent control signals “which act on the switch 34 ... to control the conferees['] telephones,” *id.*, col. 2, lines 42-45, and the switch establishes

“telephone connection status information ... for all participants,” *id.*, col. 2, lines 53-57.

Table I also distinguishes between the switch, where the conference resides, and the conferees’ telephones. Thus, Table I refers to a request that “a specified telephone number” [not a switch] be connected to a conference [the switch].” A0084, col. 3, lines 19-22. Similarly, the “call-back” embodiment notes that system software sends a telephone number “to switch 34 ... to ring the call initiator’s telephone.” A0085, col. 5, lines 4-7. Further, “records of all the connected telephone numbers are recorded at the switch 34,” *id.*, col. 5, lines 15-16, and “[e]ach connection is shown as a separate call ... originating from the switch 34, not from the calling party’s telephone,” *id.*, col. 5, lines 19-21. Thus, under no circumstances is switch 34 considered a “telephone,” a “telephone instrument,” or a “telephone device.”

In addition, there is no support whatsoever in the specification for construing “telephone devices” to include “fax machines, modems, or in some cases, a conference bridge.” A1378 n.7 (Comcast’s *Markman* Brief). The specification is silent about such equipment, which cannot allow conferees to “exchang[e] verbal information” in the same way a telephone does.

Thus, the term “telephone device” in Claim 33 and in the district court’s construction of “telephonic connection” must be construed to mean telephone instruments, not bridges, or switches like switch 34. Because of this, the court’s construction of “telephonic connection” excludes the patent’s embodiments from the scope of the claims.

III. THE INTRINSIC EVIDENCE SUPPORTS CARITAS’S CONSTRUCTION, AND REFUTES THE DISTRICT COURT’S CONSTRUCTION

As noted above and in Caritas’s main brief, the specification discloses connections made between switch 34 and a conferee telephone instrument, where the connection is associated with a specific conferee. Table I specifically gives each connection a unique “connection id used to refer to this member[’]s conference connection.” A0084, col. 3, lines 26-28. The call-back embodiment discloses the same type of connection, “from switch 34” to a conferee telephone. A0084-85, col. 4, line 40 to col. 5, line 46, A0090. The specification thus provides direct support for Caritas’s construction of “telephonic connection” as a “connection associated with a specific conferee.” Critically, it is inconsistent with the district court’s requirement that a connection be “between telephone devices.” It is also inconsistent with what Comcast calls the “ordinary meaning” of

“connection” -- precisely because the Caritas method is an invention, and is not set up like an ordinary conference.

A. “Telephonic Connections” Established By the Invention Are Different From Those Established for Ordinary Calls and Conferences

The patent’s disclosed method for setting up a telephone conference between two or more people (whether local or long-distance) establishes a connection between switch 34 and the conferee’s telephone. Most importantly, all of the invention’s connections are established using a process that sends telephonic control signals into the telephone network from outside.

This disclosed process is different from how telephone conferences and connection end points are set up for “ordinary” two-party or multi-party telephone conferences. In setting up all ordinary conferences, all call control signaling takes place entirely within the telephone network.

Comcast asserts that the claim term “telephonic connection” should be given its purported ordinary meaning -- Comcast’s shorthand for construing the claim in light of particular prior art methods rather than the patent’s disclosure. This shorthand is most evident in Comcast’s assertion that Caritas’s construction “makes no sense” for a two-person local telephone conference. Of course, Caritas’s proposed construction (“a connection over

the ... telephone network associated with a specific conferee”) does “make sense” for a two-person local telephone conference set up using the patent’s disclosed process which, for each conferee, results in a connection between switch 34 and the conferee’s telephone.

1. The Caritas Patent Discloses Establishing Telephonic Connections Between Switch 34 and a Conferee Telephone Using Control Signals Sent From Outside the Telephone Network

In seeking to improve the experience of telephone users on the PSTN, the Caritas inventors use a computer to send call control signals from outside the PSTN to cause the PSTN to establish telephonic connections for a conference among two or more conferees. As described in the first embodiment, a call control signal (for example, ESTABLISH CONNECTION) is sent from the Conference Meister’s computer (for example, PC 26) to switch interface 33 via an IP communication network. A0083, col. 2, lines 34-41. The ESTABLISH CONNECTION (“EC”) signal requests “that a specified telephone number be connected to a conference.” A0084, col. 3, lines 19-22.

Switch interface 33, which is also a computer, converts the received EC signal into the corresponding SS7 call control signal and sends the signal to switch 34 over the separate “SS7 network” within the PSTN. A0083, col. 2, lines 41-48. In response to the received signal, switch 34 proceeds --

using additional SS7 call control signals -- to set up a telephonic connection between itself and the “specified telephone number.” *See* A1019-20 (Declaration of Caritas’s Expert ¶¶ 22-25). For the connection to the first conferee, the system “returns a connection ID used to refer to this member[’s] conference connection.” A0084, col. 3, lines 23-29.

To add the second, third and additional conferees, the process needs to be repeated for each additional “specified telephone number” -- with each additional telephonic connection set up between switch 34 and the additional “specified telephone number.” Again, the system returns a connection ID for each additional “member[’]s conference connection.” *Id.*

Each conference member’s connection is set up separately, each is assigned a unique connection ID, and each is from switch 34 to the conferee’s telephone. This disclosure thus directly supports Caritas’s proposed construction, namely, “a connection ... associated with a specific conferee.” The disclosure also uses the term “connection” in a way that is incompatible with *Newton’s* definition of a connection “between telephones,” upon which the district court and Comcast relied below.

2. The Prior Art Method for Setting Up An Ordinary Two-Person Conference Differs Significantly From The Patent's Method, and Establishes a Different Kind of Connection

The “ordinary” establishment of a two-person conference begins with the detection of a change in current on a copper wire connected between a calling party’s telephone and a switch, not the receipt of call control signals sent from a computer outside the PSTN as described in the patent. A1403 (Declaration of Comcast’s Expert ¶¶ 9-10). *See also* Comcast Brief at 20. For a local call, the switch never transmits or receives any call control signals via the SS7 network. Instead, the switch sends electrical current across the copper wire connecting it to the called party’s telephone, causing the telephone to ring. A1406 (Declaration of Comcast’s Expert ¶ 21). When the called party answers, the switch once again detects a change in current on the connecting copper wire. A1403-04 (*id.* ¶ 10). In response, the switch establishes one connection between the calling party’s telephone and the called party’s telephone, *id.*, not the two telephonic connections described in the patent.

In a long distance call, the switch transmits and receives call control signals via the SS7 network, A1406 (*id.* ¶¶ 20-22), but all call control signals remain within the PSTN. Like a local call, the switch establishes one connection between the calling party’s telephone and the called party’s

telephone. *Id.* ¶ 22. Thus, in both the ordinary local and long distance calls, the connections are, as *Newton*'s dictionary definition suggests, "between telephones." In the patent, however, each connection is made between switch 34 and a telephone, not between telephones.

3. The Prior Art Method of Setting Up A Three-Person Conference Using a Conference Bridge Also Differs Significantly From The Patent's Method, and Establishes a Connection Excluded From the District Court's Definition

Ordinary three-person conferences are set up using one of two different prior art methods. One establishes *Newton*-like telephone-to-telephone connections. The other establishes bridge-to-telephone connections excluded from *Newton*'s definition, and excluded from the district court's construction. Thus, even some "ordinary" three-person conferences do not fall within the definition proffered by Comcast and adopted by the district court.

In the first method, the conference is set up using the "flash hook" feature of a telephone. A1407 (Declaration of Comcast's Expert ¶ 25). This feature allows Party A to add Party C to his call with Party B. In practice, Party A: (1) presses and releases the telephone's disconnect hook, (2) receives a dial tone, (3) dials Party C and, when Party C has answered, (4) presses and releases the disconnect hook again. In response, the switch

“conferences” Party A with Parties B and C. *Id.* According to Comcast, this three-person conference has two connections: (1) one between Party A and Party B, and (2) one between Party A and Party C. *Id.* Because there are telephone-to-telephone connections, they are different from the switch-to-telephone connections disclosed in the specification.

In the second prior art method, a three-person conference uses a dial-in conference bridge or a dial-out conference bridge. In the former, a conferee dials the telephone number for the conference bridge and, in response, is prompted to enter a pre-designated PIN for the conference. A1407-08 (*id.* ¶ 27). In the latter, the bridge dials the telephone number for each conferee at a pre-designated time. Neither bridge receives call control signals from outside the PSTN -- as disclosed in the patent.

Unlike the switches used in the other prior art methods of setting up ordinary conferences, conference bridges are connection end points, with the connection for each conferee being between the bridge and the conferee’s telephone. *See, e.g.*, A1725 (Comcast Hearing Presentation). Because the prior art conference bridge method does not establish telephone-to-telephone connections, it is excluded from *Newton*’s definition of “connection,” showing that the definition does not encompass the true “ordinary meaning” of the term “connection.” These connections are also excluded, as are the

invention's connections, from the district court's construction because they are not between telephones.

B. Comcast's Claim To "Ordinary Meaning" Is False

Cloaking itself in the mantra of "ordinary meaning," Comcast argues the term "telephonic connection" appears nowhere in the specification, while arguing that the district court's construction is merely the "ordinary meaning" of the term. However, as explained above, the term "telephonic connection" as defined by Comcast and the district court, does not encompass all "ordinary" calls, nor does it appear in dictionaries, treatises, or any other extrinsic evidence. Thus, there is no "ordinary meaning" for the complete phrase "telephonic connection."

Rather, both parties focus on the separate words "telephonic" and "connection," with emphasis on "connection." Caritas focuses on how "connection" is used in the specification (including Table I), emphasizing that the term must be considered in context, as required by *Phillips*.

Comcast relies on *Newton's* dictionary definition, which it says sets forth the "ordinary meaning" of the term "connection."

Newton's definition of "connection" -- "between telephones" -- is inappropriate because it concerns telephone connections for ordinary telephone calls, not connections for conferences of the invention. As the

patent makes clear, the invention establishes conferences in a very different way than the way in which ordinary telephone calls and conferences are established, and thus the “connections” established by the invention are different as well. In addition, as noted above, even *Newton’s* definition excludes the ordinary prior art method of establishing conferences using dial-in and dial-out conference bridges, calling into question whether *Newton’s* truly sets forth an “ordinary meaning” at all.

Comcast tries to have it both ways: it first says *Newton’s* is correct (“between telephones”), then tries to specially redefine “telephones” to mean something entirely different: “a bridge and a conferee telephone.” Comcast Brief at 37-38. This “having it both ways” mentality is shown when Comcast says, in a single paragraph in its brief, both that “connection” in Table I comports with *Newton’s* definition, and that the district court “properly modified” *Newton’s* definition “based on Table I’s more expansive use of that term.” *Id.* As discussed above in Section I, the court did not “modify” the ordinary meaning of “connection,” but rather adopted *Newton’s* definition without reference to how the term is used in the specification.

C. The District Court's Construction of "Telephonic Connections" Improperly Imports Extraneous Limitations Into Claim 33

Substituting the district court's definition of "telephonic connection" into Claim 33 shows the inconsistency of the court's construction with the actual language of Claim 33. The district court's construction inserts "between" where "to" was specified by the applicants, and specifies two "telephone devices" where the applicants specified "at least one." These inserted requirements: (1) add extraneous limitations to the claim; (2) contradict the explicit language of the claim; and (3) render the applicants' chosen language redundant.

Comcast does not dispute the inconsistencies present in the court's construction of Claim 33. For example, Comcast does not dispute that Claim 33 specifies only one "end point" of a telephonic connection -- not two. Comcast does not dispute that the applicants could have specified -- but did not -- a connection between two "end points" (or between two telephone devices). It does not dispute that importing the terms "between" and "telephone devices" (plural) into the meaning of "telephonic connection" makes "to at least one conferee telephone device" redundant.

Instead, Comcast whitewashes the district court's construction with an argument that the "inherent" meaning of the word "connect" requires two

things to be connected and, in the context of the patent, those “things” are telephone devices. Comcast Brief at 51-52. This “inherency” argument is no different than Comcast’s “ordinary meaning” argument -- it is just dressed up with a new set of words. Comcast’s concluding sentence in this section makes this clear: “construing the term ‘telephonic connection’ as the path ‘between telephone devices’ simply comports with the ordinary meaning of a circuit-switched connection ...” *Id.* at 52. As discussed above, Comcast’s claim to “ordinary meaning” is false, and the purported “ordinary meaning” of the word “connection” is incompatible with the disclosure of the patent.

Importing into Claim 33 an “inherent” limitation is no more proper than importing language from the specification into the claim. *Phillips*, 415 F.3d at 1325-26 (inclusion in claim of additional limitation on term “baffles” made it likely patentee did not contemplate that the term already inherently contained that limitation); *Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc.*, 381 F.3d 1111, 1117 (Fed. Cir. 2004) (particular embodiments “will not be used to limit language that has broader effect”). Simply put, Comcast cannot answer why the applicants would specifically choose the language “at least one” if they really meant two, or would use “to” if they really meant “between.”

On the other hand, Caritas's proposed construction is consistent with the claim language. The term "telephonic connection" requires that the connection be on the telephone network, and that it be associated with a specific conferee. It does not, by itself, require any end point -- rather, as set forth in Table I, it merely requires that each connection be associated with a conferee, without specifying the specific hardware used to join the conferee to the conference. Additional language in Claim 33 then specifies one end point of the connection, namely, "at least one conferee telephone device."

D. Comcast Does Not Dispute That Claims 1 and 17 Are Not Limited To a Specific End Point

Comcast ignores the two remaining independent claims, Claims 1 and 17, which are broader in scope than Claim 33 because they do not require the telephonic connection be "to at least one conferee telephone device."

A085, col. 5, line 58 - col. 6, line 11, A0088; A0086, col. 7, lines 9-19, A0088. Thus, Comcast does not dispute that even if "end point" limitations ("to," or "between") are appropriate for Claim 33, they are not appropriate for Claims 1 and 17, and these claims should not be limited to specific end points for the "telephonic connection." *Phillips*, 415 F.3d at 1325-26.

E. Dependent Claims 9 and 10 Support Caritas's Proposed Construction, and Refute the District Court's Construction

Under Caritas's proposed construction, every connection is associated with a specific conferee. In the independent claims, however, which conferee is associated with which connection is not specified. In contrast, dependent Claims 9, 25 and 38, do specify which conferee (*i.e.*, the added conferee) is associated with which connection (*i.e.*, the added connection). A0085, col. 6, lines 46-54; A0086, col. 7, line 62 - col. 8, line 3; A0086-87, col. 8, line 62 - col. 9, line 2. Dependent Claims 10, 26 and 39 also include a similar narrowing limitation, specifying that the "removed connection" is associated with the "removed conferee." A0085, col. 6, lines 55-63; A0086, col. 8, lines 4-11; A0087, col. 9, lines 3-10. Thus, under Caritas's proposed construction, all the claim terms have meaning, with the phrases "for the added conferee" and "for the removed conferee" narrowing the established connection to a particular conferee -- a limitation consistent with, but not already present in, the construed claim term "telephonic connection."

The district court's construction, on the other hand, is incompatible with these claims, because a connection "between" two telephones (conferee-to-conferee) is, by its very nature, associated with both conferees, not a particular conferee. Comcast concedes this point. Comcast Brief at 34 ("at no point is the connection [between two telephones] 'associated' with a

particular conferee”) (emphasis added). Thus, under the court’s construction, the established path between the telephone devices is for both the existing conferee and the added (or removed) conferee, rendering the phrases “for the added conferee” (Claims 9, 25 and 38) and “for the removed conferee (Claims 10, 26 and 39) meaningless. *Innova*, 381 F.3d at 1119 (“all claim terms are presumed to have meaning in a claim”).

F. The Prosecution History Supports Caritas’s Proposed Construction

The prosecution history concerns four Caritas patents: the Caritas patent at issue here; the ‘780 patent issued on June 6, 2000; the ‘328 patent issued on July 24, 2001; and the ‘474 patent issued on November 12, 2002. Each patent claims priority to a provisional application filed on August 26, 1996. The prosecution history is consistent with the claims and specification in the Caritas patent and supports Caritas’s proposed construction.

1. The ‘780 Patent’s Use Of the Term “Telephonic Connections” Supports Caritas’s Proposed Construction

The ‘780 patent contains 25 claims, four of which are independent claims. The term “telephonic connections” appears in one claim, independent method Claim 19 -- “telephonic connections among a first plurality of telephone devices.” A0541, col. 8, lines 5-6 (emphasis added). This recitation of more than one telephonic connection among more than one

telephone device is consistent with Table I's disclosure of one connection

for each conferee to the conference. In addition, like the Caritas patent

claims, this claim sets up not an entire conference, but just one telephonic

connection for one telephone device: "switch module ... adapted to dial up

at least one of said telephone devices ... whereby the telephone device ... is

activated by said switch." A0541, col. 8, lines 19-38 (emphasis added). See

Rodime PLC v. Seagate Tech., Inc. 174 F.3d 1294, 1303 (Fed. Cir. 1999)

("claim need not claim every function of a working device"). Thus, the

claim of the '780 patent that uses the term "telephonic connection" supports

Caritas's proposed construction requiring a connection to be associated with

a specific conferee, and is inconsistent with the court's construction

requiring a connection between two telephones.

2. The Abstracts' Use Of the Term "Telephonic Connections" Supports Caritas's Proposed Construction

The Abstracts of the '780 patent and the '328 patent mirror the

Abstract of the Caritas patent, which reads in part: "In a telephone

conferencing system, a digital communication network is used to establish

and control the telephone connections between multiple conferees...."

A0077 (Caritas Patent); A0534 ('780 patent); A0543 ('328 patent)

(emphasis added). This recitation of more than one telephone connection

among more than one conferee is similar to the claim language discussed above regarding the '780 patent. Thus, the specification's use of the term "telephone connection" supports Caritas's construction, and is inconsistent with the district court's construction.

Comcast ignores the Abstract of the '474 patent, which clearly states that the digital communication network "is used to establish and control the telephone connections between two conferees." A0552 (emphasis added). This passage makes clear that two conferees have two telephonic connections, not the one connection demanded by Comcast and the district court's construction.

3. Caritas's Statements Regarding the White Patent Support Caritas's Proposed Construction and Refute Comcast's Argument That Caritas Disclaimed Coverage Of VoIP

Comcast's entire argument about the White patent fundamentally rests upon a falsehood regarding what Caritas told the Examiner about White and a "telephone connection." This is shown by merely comparing Comcast's allegations with applicants' actual words in the prosecution history:

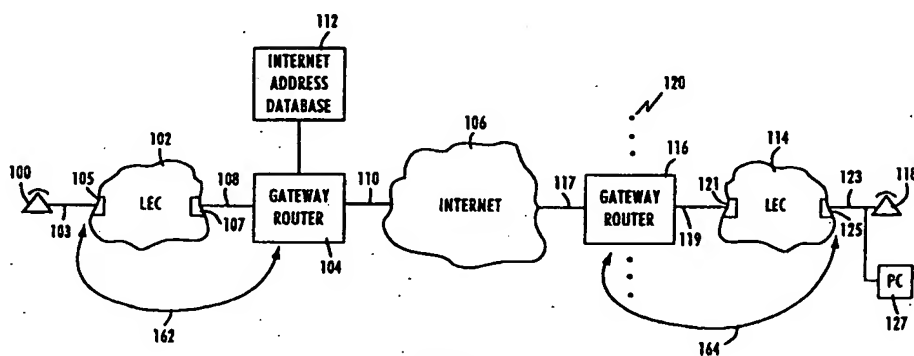


FIG. 4

What Comcast Says Caritas Told the Examiner (emphasis added)	What Caritas Actually Told the Examiner (emphasis added)
<p>“In its arguments to the Examiner, Caritas said that the White patent did <u>not</u> disclose telephonic connections ...”</p> <p>“Caritas’s representation that White does <u>not</u> disclose a ‘telephonic connection’ ...”</p> <p>“Caritas argued ... that White did <u>not</u> disclose a ‘telephone connection in a telephone network.’”</p> <p>Comcast Brief at 30, 48 and 49, respectively (emphasis added).</p>	<p>“In no case does White use or suggest a digital computer attached to the Internet to initiate or otherwise control a telephone connection in a telephone network. <u>Rather, in White, a telephone connection is established by using conventional dial-up procedures ...</u>”</p> <p>A0962 (emphasis added).</p>

As Caritas told the Examiner, White does disclose a “telephone connection” -- a connection between a telephone and a gateway router -- not a connection between two telephones, as construed by the district court. Caritas’s statement that White does establish a telephone connection supports Caritas’s claim construction, and refutes the district court’s construction, which requires an end-to-end circuit-switched path between conferees not present in White.

White, like Comcast’s CDV system, contains both a telephonic connection and an internet protocol path, as shown in the figure on the opposite page. A circuit-switched path exists between each telephone and a

gateway, and an internet protocol path exists between the gateways.

Because, as applicants stated, White clearly contains a telephonic connection as part of a system which also contains an internet path for voice, applicants did not disclaim VoIP from the invention.

CONCLUSION

The judgment of noninfringement should be vacated because the district court's claim construction is erroneous. The dispute raised in Comcast's brief regarding "telephone devices" also requires that the judgment be vacated, because (a) the court's claim construction is not "saved" by redefining "telephone device," (b) "telephone device" should not be construed for the first time on appeal, and (c) if "telephone device" is construed as Comcast suggests, all factual support for the district court's conclusion of noninfringement is destroyed.

Dated: March 22, 2007

Respectfully submitted

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This brief contains 6850 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(a)(7)(B)(iii).

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Dated: March 22, 2007

Kerry L. Timbers

PROOF OF SERVICE

I certify that I filed 12 copies of this brief, including one original, with the clerk of the U.S. Court of Appeals for the Federal Circuit by Federal Express and served two copies on Matthias A. Kamber of KEKER & VAN NEST, LLP, 710 Sansome Street, San Francisco, CA 94111, counsel for appellees, by Federal Express, this 22nd day of March, 2007.

Kerry L. Timbers